

05/11/01
JC985 U.S. PTO

05-14-01

A/Re

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PTO/SB/50 (08-00)
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JC997 U.S. PTO
09/853852
05/11/01

REISSUE PATENT APPLICATION TRANSMITTAL

Address to:

Assistant Commissioner for Patents
Box Reissue
Washington, DC 20231

Attorney Docket No.	153501-0357
First Named Inventor	Geis, E. et al.
Original Patent Number	5,903,385 11b
Original Patent Issue Date (Month/Day/Year)	May 11, 1999
Express Mail Label No.	EL 088 713 794 US

APPLICATION FOR REISSUE OF:
(Check applicable box)



Utility Patent



Design Patent



Plant Patent

APPLICATION ELEMENTS (37 CFR 1.173)

- ☒ Fee Transmittal Form (PTO/SB/ 56)
(Submit an original, and a duplicate for fee processing)
- ☒ Applicant claims small entity status. See 37 CFR 1.27.
- ☒ Specification and Claims in double column copy of patent
format (amended, if appropriate)
- ☒ Drawing(s) (proposed amendments, if appropriate)
- ☒ Reissue Oath/Declaration (original or copy)
(37 C.F.R. § 1.175) (PTO/SB/51 or 52)
- Original U.S. Patent currently assigned?
☒ Yes ☐ No
(If Yes, check applicable box(es))
☒ Written Consent of all Assignees (PTO/SB/53) (unexecuted)
☒ 37 C.F.R. § 3.73(b) Statement (PTO/SB/96)(unexecuted) ☒ Power of
Attorney (unexecuted)

ACCOMPANYING APPLICATION PARTS

- ☐ Statement of status/support for all changes to
the claims. See 37 CFR 1.173 (c).
- ☐ Original U.S. Patent for surrender
☐ Ribboned Original Patent Grant
☐ Statement of Loss (PTO/SB/55)
- ☐ Foreign Priority Claim (35 U.S.C. 119)
(if applicable)
- ☒ Information Disclosure ☒ Copies of IDS
Statement (IDS)/PTO-1449 Citations
- ☐ English Translation of Reissue Oath/Declaration
(if applicable)
- ☒ Preliminary Amendment
- ☒ Return Receipt Postcard (MPEP 503)
(Should be specifically itemized)
- Other: **Request for Abstract of Title**

15. CORRESPONDENCE ADDRESS

☐ Customer Number or Bar Code Label

(Insert Customer No. or Attach bar code label here)

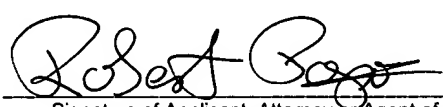
or ☒ Correspondence address below

Name	IRELL & MANELLA LLP				
Address	1800 Avenue of the Stars				
	Suite 900				
City	Los Angeles	State	CA	Zip Code	90067-4276
Country	U.S.A.	Telephone	310-277-1010	Fax	310-203-7199

NAME (Print/Type)	Robert Popa	Registration No. (Attorney/Agent)	43,010
Signature	<i>Robert Popa</i>	Date	May 11, 2001

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REISSUE APPLICATION FEE TRANSMITTAL FORM						Docket Number (Optional) 153501-0357		
Claims as Filed - Part 1								
Claims in Patent		Number Filed in Reissue Application	(3) Number Extra	Small Entity		Other than a Small Entity		
				Rate	Fee	Rate	Fee	
(A) 25	Total Claims (37 CFR 1.16(j))	(B) 25	**** 0 =	x \$ 0 =		or	x \$ ____ =	
(C) 8	Independent claims (37 CFR 1.16(i))	(D) 8	* 0 =	x \$ 0 =			x \$ ____ =	
Basic Fee (37 CFR 1.16(h))					\$ 355		\$ ____	
Total Filing Fee					\$ 355	OR	\$	
Claims as Amended - Part 2								
	(1) Claims Remaining After Amendment		(2) Highest Number Previously Paid For	(3) Extra Claims Present	Small Entity		Other than a Small Entity	
					Rate	Fee	Rate	Fee
Total Claims (37 CFR 1.16(j))	*** 231	MINUS	** 25	* = 206	x \$ 9 =	1854		x \$ ____ =
Independent Claims (37 CFR 1.16(i))	*** 25	MINUS	***** 8	= 17	x \$ 40 =	680		x \$ ____ =
Total Additional Fee					2534	OR	\$	
<p>* If the entry in (D) is less than the entry in (C), Write "0" in column 3.</p> <p>** If the "Highest Number of Total Claims Previously Paid For" is less than 20, Write "20" in this space.</p> <p>*** After any cancellation of claims.</p> <p>**** If "A" is greater than 20, use (B - A); if "A" is 20 or less, use (B - 20).</p> <p>***** "Highest Number of Independent Claims Previously Paid For" or Number of Independent Claims in Patent (C).</p>								
<p><input checked="" type="checkbox"/> Applicant claims small entity status. See 37 CFR 1.27.</p> <p><input type="checkbox"/> Please charge Deposit Account No. _____ in the amount of _____. A duplicate copy of this sheet is enclosed.</p> <p><input checked="" type="checkbox"/> The Commissioner is hereby authorized to charge any additional fees under 37 CFR 1.16 or 1.17 which may be required, or credit any overpayment to Deposit Account No. 09-0946. A duplicate copy of this sheet is enclosed.</p> <p><input checked="" type="checkbox"/> A check in the amount of \$ 2889.00 to cover the filing / additional fee is enclosed.</p> <p><input type="checkbox"/> Payment by credit card. Form PTO-2038 is attached.</p>								
<p>WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.</p>								
<p>05/11/01 Date</p>				<p style="text-align: center;"> Signature of Applicant, Attorney or Agent of Record</p> <p style="text-align: center;">Robert Popa Typed or printed name</p>				

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re reissue application of:)
)
 U. S. Patent No: **5,903,136**)
)
 Issued : **May 11, 1999**)
)
 Inventor(s) : **Geis, E. et al.**)
)
 For : **Turbogenerator/Motor Controller**)
)
 _____)

ASSENT OF ASSIGNEE
AND CERTIFICATION UNDER 37 CFR 3.73(b)

Commissioner for Patents
 Washington, D.C. 20231

Sir:

Capstone Turbine Corporation, assignee of the entire interest in the above-referenced letters patent, hereby assents to the accompanying application for reissue.

Capstone Turbine Corporation, ("assignee"), a corporation having a place of business at 21211 Nordhoff Street, Chatsworth, California 91311, certifies that to the best of assignee's knowledge and belief it is the assignee of the entire right, title, and interest in and to the above-referenced patent and represents that the undersigned is a representative authorized and empowered to sign on behalf of the assignee.

CAPSTONE TURBINE CORPORATION

Dated: _____

By: Jeffrey Watts
 Its: Chief Financial Officer

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REISSUE APPLICATION: CONSENT OF ASSIGNEE; STATEMENT OF NON-ASSIGNMENT		Docket Number (Optional) 153501-0357
This is part of the application for a reissue patent based on the original patent identified below.		
Name of Patentee(s) Capstone Turbine Corporation		
Patent Number	5,903,116	Date Patent Issued May 11, 1999
Title of Invention Turbogenerator/Motor Controller		
<p>1. <input checked="" type="checkbox"/> Filed herein is a statement under 37 CFR 3.73(b). (Form PTO/SB/96)</p> <p>2. <input type="checkbox"/> Ownership of the patent is in the inventor(s), and no assignment of the patent is in effect.</p> <p>One of boxes 1 or 2 above must be checked. If multiple assignees, complete this form for each assignee. If box 2 is checked, skip the next entry and go directly to "Name of Assignee".</p> <p>The written consent of all assignees and inventors owning an undivided interest in the original patent is included in this application for reissue.</p>		
The assignee(s) owning an undivided interest in said original patent is/are <u>Capstone Turbine Corporation</u> and the assignee(s) consents to the accompanying application for reissue.		
Name of assignee/inventor (if not assigned) Capstone Turbine Corporation		
Signature	Date	
Typed or printed name and title of person signing for assignee (if assigned) Jeffrey Watts, Chief Financial Officer		

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re reissue application of:)
U. S. Patent No: **5,903,116**)
Issued : **May 11, 1999**)
Inventor(s) : **Geis, E. et al.**)
For : **Turbogenerator/Motor**)
Controller)

REQUEST FOR ABSTRACT OF TITLE

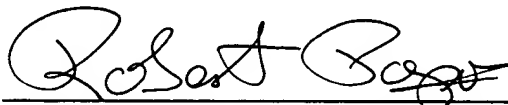
Box REISSUE
Commissioner for Patents
Washington, D.C. 20231

Sir:

Please prepare a certified Abstract of Title in respect of the above identified original patent for placing in the official file of the Reissue Application which is filed herewith.

Please charge \$25.00, in accordance with 37 CFR 1.19(b)(4), to Deposit Account No. 09-0946, for which purpose a duplicate of this paper is enclosed.

Respectfully submitted,



Robert Popa (Registration No. 43,010)

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UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENT
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

DATE: March 24, 2003

TO: K. Masih, PE
A.U. 2837

VIA: Robert Nappi, SPE
A.U. 2837

FROM: Hien H. Phan, SPE

RE: REISSUE APPLICATION No. 09/853,852

This reissue is for patent No. 5,903,116, issued May 11, 1999..

Apparently, this file was declared lost. It was turned in for counting. The LIE brought the case to have the lost flag removed and the withdrawal of attorney request processed. As it turns out, this case has not been reviewed nor docketed.

A preliminary review reveals that the application contains the following deficiencies:

1. The reissue declaration:
The declaration filed September 24, 2001 does not comply with 37 CFR 1.63 because it refers to the specification attached thereto. The specification was filed on May 11, 2001 before the filing of the signed declaration.
2. The amendment adding claims 26 through 231 is in improper format because the claims are not underlined as required by 37 CFR 1.173(d). Also, the amendment is not accompanied by "an explanation of the support in the disclosure of the patent for the changes made to the claims" as required under 37 CFR 1.173(c). Further, the amendments to the specification and to the claims have not been entered. The determination of whether the addition to the specification add new matter to the patent is with the examiner.
3. It appears that the new claims have significantly broadened the scope of the patent. For example, claim 26 is so broad that it may read on a perpetual motion machine. Note that there is a SAWS program in TC 2800 and determination of whether to include this application in SAWS is with the examiner and SPE.
4. The patent file is currently with the examiner. No review is made with respect to the prohibition of the new claims by the recapture rule.

5. It is also noted PALM ExPo shows that there is a second reissue 10/305,112 which was filed as a continuation of this reissue. Also, there are several continuations of the patent currently pending. These are 10/008,246 and 10/077,121. Also the patent has a continuing case 09/207,817 which has several child applications stemming from it.

6. It does not appear that the case has been processed by the tech. Support since other papers such as the IDS have not been entered.

Please check with me if clarification/assistance is needed.